

**REMARKS/ARGUMENTS**

The Office Action mailed April 13, 2005 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Applicants gratefully acknowledge the indication of allowance of claims 22-39.

Claims 1, 8 and 15 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification, paragraph [0055]. The text of claims 2-7, 9-14 and 16-21 is unchanged, but their meaning is changed because they depend from amended claims.

New claims 40-45 also particularly point out and distinctly claim subject matter regarded as the invention. Support for these claims may be found in the specification, paragraph [0060] through [0065].

With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

**The First 35 U.S.C. § 103 Rejection**

Claims 1, 3, 4 and 7 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stumer et al.<sup>1</sup> in view of McCalmont et al.<sup>2</sup>, among which claim 1 is an independent claim. This rejection is respectfully traversed.

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<sup>1</sup> U.S. Patent No. 6,678,357

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>3</sup>

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Stumer except that Stumer does not teach authenticating the VoIP telephone.<sup>4</sup> The Office Action further contends that McCalmount teaches authenticating a VoIP telephone and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate McCalmount into Stumer in order to ensure service only for authorized users. The Applicants respectfully disagree for the reasons set forth below.

Claim 1 as amended clarifies that the transmitting of the unique device identifier and the physical location identifier to an E911 database management system is done "in response to said detecting and said authenticating". As described in the specification, paragraph [0055], the method may be "repeated whenever a VoIP telephone 108 is coupled to a network port 204." As stated in paragraph [0056], the result of this is that "the local PSAP 135 can now access the newly updated ALI database by interfacing with the E911 database management system 137. In the event a 9-1-1 call originates with the VoIP telephone 108, the PSAP operator will have an accurate location and a call-back telephone number for the VoIP telephone 108."

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<sup>2</sup> U.S. Patent No. 6,771,742

<sup>3</sup> M.P.E.P. § 2143.

<sup>4</sup> Office Action ¶ 2.

Neither Stumer nor McCalmont transmit the unique device identifier and physical location identifier to the E911 database in response to the detecting and/or the authenticating. On both references, the information is only transmitted when an emergency call is placed. In Stumer, "[e]very port or end user jack in the network is assigned a Source Group Index (SGI), regardless of whether a port is physical or logical, e.g., for multi-drop. An SGI is a number or index representing each PSAP jurisdiction in the network." Col. 2, lines 52-56. Col. 5, lines 54-59 states that "[a]n ECI table 152 entry is attached to any emergency messages that are sent from or received by the network entity. ECI data table 152 includes a port equipment number (PEN) field, a port source group index number (SGI) field and a local PSAP emergency location identifier number (ELINx) field." There is no evidence in Stumer of the transmission of the SGI for a particular VoIP telephone to the E911 system before the emergency call is placed, let alone in response to detecting the VoIP telephone and authenticating it.

In McCalmont, a location for a VoIP telephone is saved locally at a call center database "maintained by the VoIP service provider." (see col. 4, lines 35-40). However, this information is not transmitted to the E911 system until the time of the emergency call ("[f]or the call origination scenario, the ACN center, PAM center or VoIP service provider (or ESCC), may use a computer telephony integration (CTI) application where the call center database (CCSB) queries, across an interface provided in connection with an embodiment of the present invention, a positioning server (PS) system in an emergency services complex (ESC) node, passing the latitude, longitude and other relevant information related to the caller" Col. 4, lines 46-53). There is no evidence in McCalmont of the transmission of this location information for a

particular VoIP telephone to the E911 system before the emergency call is placed, let alone in response to detecting the VoIP telephone and authenticating it.

As such, Applicant respectfully submits that claim 1 as amended is in condition for allowance.

As to dependent claims 3, 4 and 7, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

#### The Second 35 U.S.C. § 103 Rejection

Claim 2 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stumer in view of McCalmont, as applied to claim 1 above, and further in view of Bahl et al.<sup>5</sup>. This rejection is respectfully traversed.

As to dependent claim 2, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

#### The Third 35 U.S.C. § 103 Rejection

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Stumer in view of McCalmont, as applied to claim 1 above, and further in view of Szeto et al.<sup>6</sup>. This rejection is respectfully traversed.

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<sup>5</sup> U.S. Patent No. 6,782,422

As to dependent claims 5 and 6, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

#### The Fourth 35 U.S.C. § 103 Rejection

Claims 8, 10-12, 14, 15, 17-19 and 21 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Oran et al.<sup>7</sup>, McCalmont and Lindsay et al.<sup>8</sup>, among which claims 8 and 15 are independent claims. This rejection is respectfully traversed.

Claims 8 and 15 as amended clarify that the transmitting of the unique device identifier and the physical location identifier to an E911 database management system is done "in response to said detecting and said authenticating". As described in the specification, paragraph [0055], the method may be "repeated whenever a VoIP telephone 108 is coupled to a network port 204." As stated in paragraph [0056], the result of this is that "the local PSAP 135 can now access the newly updated ALI database by interfacing with the E911 database management system 137. In the event a 9-1-1 call originates with the VoIP telephone 108, the PSAP operator will have an accurate location and a call-back telephone number for the VoIP telephone 108."

Neither Oran nor McCalmont nor Lindsay transmit the unique device identifier and physical location identifier to the E911 database in response to the detecting and/or the authenticating. On all three references, the information is only transmitted when an emergency call is placed. In Oran, "switch 124 retrieves the physical coordinates for the port, e.g., P3, on

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<sup>6</sup> U.S. Patent No. 6,618,476

<sup>7</sup> U.S. Patent No. 6,665,611 B1

<sup>8</sup> U.S. Patent No. 6,526,125

which the 911 call originated. These physical coordinates are then either appended to the 911 'call' being routed to the PSAP or they may be sent in a separate message to the PSAP." Col. 10, lines 30-34. There is no evidence in Oran of the transmission of the coordinates for a particular VoIP telephone to the E911 system before the emergency call is placed, let alone in response to detecting the VoIP telephone and authenticating it.

In McCalmont, a location for a VoIP telephone is saved locally at a call center database "maintained by the VoIP service provider." (see col. 4, lines 35-40). However, this information is not transmitted to the E911 system until the time of the emergency call ("[f]or the call origination scenario, the ACN center, PAM center or VoIP service provider (or ESCC), may use a computer telephony integration (CTI) application where the call center database (CCSB) queries, across an interface provided in connection with an embodiment of the present invention, a positioning server (PS) system in an emergency services complex (ESC) node, passing the latitude, longitude and other relevant information related to the caller" Col. 4, lines 46-53). There is no evidence in McCalmont of the transmission of this location information for a particular VoIP telephone to the E911 system before the emergency call is placed, let alone in response to detecting the VoIP telephone and authenticating it.

In Lindsay, "a method for electronic correction and notification of discrepancies relating to automatic location identification information in a telephone environment (in its preferred embodiment implemented in an emergency call 911 telephone system) begins with a telephone customer calling party dialing 911, as indicated by a block 50." Col. 4, lines 36-42. There is no evidence in Lindsay of the transmission of this location identification information for a particular

VoIP telephone to the E911 system before the emergency call is placed, let alone in response to detecting the VoIP telephone and authenticating it.

As such, Applicant respectfully submits that claims 8 and 15 as amended are in condition for allowance.

As to dependent claims 10-12, 14, 17-19 and 21, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Fifth 35 U.S.C. § 103 Rejection

Claims 9 and 16 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Oran and McCalmont and Lindsay, as applied to claims 8 and 15 above, and further in view of Bahl. This rejection is respectfully traversed.

As to dependent claims 9 and 16, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Sixth 35 U.S.C. § 103 Rejection

Claims 13 and 20 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Oran and McCalmont and Lindsay, as applied to claims 8 and 15 above, and further in view of Szeto. This rejection is respectfully traversed.

As to dependent claims 13 and 20, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

### Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.



Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

Dated: \_\_\_\_\_

5/26/03



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